

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte FRANK D'ANGELO  
and MARIO DIBARTOLOMEO

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Appeal No. 2002-1019  
Application 09/433,570

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ON BRIEF

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Before FRANKFORT, STAAB, and MCQUADE, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Frank D'Angelo et al. appeal from the final rejection of claims 1 through 24, all of the claims pending in the application.

THE INVENTION

The invention relates to a golf putting aid/brace member which is defined in representative claims 1, 9 and 16 as follows:

1. A golfing aid that promotes the positioning of hands, arms and shoulders in a triangulated position of constant triangle comprising:  
an elongate shaft having first and second ends;

a grip disposed on said shaft at an intermediate portion between said first and second ends;

an upper brace portion defined in said shaft between said grip and said second end, said upper brace portion including a substantially planar anchor adjacent to said second end, said anchor being configured to fit comfortably against a golfer's armpit, in the case of a right handed golfer, under the left armpit and vice versa for a left handed golfer, and

at least one bend defined in said upper brace portion for locating said anchor against a golfer's armpit while a portion of said shaft located between the grip and said first end is disposed on an axis centered between said golfer's shoulders.

9. A brace member that assists in maintaining the positioning of hands, arms and shoulders in a triangular position of constant triangle, said brace member being mounted to a golf putter having a putter head, a putter shaft and a grip, the brace member comprising;

an elongate shaft having first and second ends,

a putter attachment disposed at said first end of said shaft for attaching said brace member to the golf putter,

a brace portion defined in said shaft between said putter attachment and said second end, said brace portion including an anchor adjacent to said second end, said anchor being configured to fit comfortably within a golfer's armpit, under the left armpit in the case of a right handed golfer, and vice versa for [sic, for] a left hand golfer, and

at least one bend being defined in said brace portion for locating said anchor against a golfer's armpit while the putter attachment supports the golf putter in axis centered between the golfer's shoulders.

16. A brace member for a golf putter that assists the hand[s], wrists and arms to be maintained in a locked, triangulated position, said putter having a putter head, a shaft and a grip, said brace member comprising;

a lower arm brace extending from the grip parallel [sic, parallel] to a golfer's arm between the wrist and elbow,

an upper arm brace connected to the lower arm brace, the upper arm brace extending at an angle relative to the lower arm brace so as to extend generally parallel to a golfer's arm between the elbow and the armpit when the golfer is in a putting stance, said armpit being the left armpit when the golfer is in a

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right hand putting stance, said armpit being the right armpit when the golfer is in a left handed putting stance,  
a planar anchor connected to the arm brace, the anchor extending parallel to the golfer's armpit.

#### THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Tischler	5,465,971	Nov. 14, 1995
Harrison	5,649,870	Jul. 22, 1997
Middleton	5,733,203	Mar. 31, 1998

#### THE REJECTIONS

Claims 1 through 24 stand rejected under 35 U.S.C. § 112, first paragraph.

Claims 1 through 24 stand rejected under 35 U.S.C. § 112, second paragraph.

Claims 1 through 16, 22 and 23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Tischler, and in the alternative under 35 U.S.C. § 103(a) as being obvious over Tischler.

Claims 17 through 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tischler.

Claims 21 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tischler in view of Harrison and Middleton.

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Attention is directed to the appellants' main and reply briefs (Paper Nos. 15 and 17) and to the examiner's final rejection and answer (Paper Nos. 9 and 16) for the respective positions of the appellants and the examiner with regard to the merits of these rejections.

### DISCUSSION

#### I. Preliminary matters

In the briefs, the appellants discuss the refusal of the examiner to enter an amendment (Paper No. 10) filed subsequent to final rejection. It is well settled, however, that the refusal of an examiner to enter such an amendment is a matter of discretion reviewable by petition to the Director rather than by appeal to this Board. In re Mindick, 371 F.2d 892, 894, 152 USPQ 566, 568 (CCPA 1967). The appellants also discuss the objections in the final rejection to the drawings under 37 CFR § 1.83(a) and to the amendment filed May 17, 2001 (Paper No. 8) under 35 U.S.C. § 132 as containing new matter. The drawing objection is not directly connected with the merits of issues involving a rejection of claims and therefore is reviewable by petition to the Director rather than by appeal to this Board. See In re Hengehold, 440 F.2d 1395, 1403-1404, 169 USPQ 473, 479 (CCPA 1971). On the other hand, the 35 U.S.C. § 132 objection

seemingly is directly connected with the merits of the 35 U.S.C. § 112, first paragraph, rejection on appeal. Thus, to the extent that this objection is inconsistent with our treatment of the rejection, it should be withdrawn.

II. The 35 U.S.C. § 112, first paragraph, rejection of claims 1 through 24

This rejection rests on the examiner's determination that the appellants' specification fails to comply with both the written description and enablement requirements of § 112, ¶ 1.<sup>1</sup>

In the examiner's view, the specification lacks written descriptive support for the subject matter now recited in the appealed claims because "[i]n Claim 1 the added recitation 'in the case . . . handed golfer', in Claim 9 the added recitation 'under the left . . . handed golfer', and in Claim 16 the added recitation 'said armpit . . . putting stance' and 'planar' is new matter" (final rejection, page 3). In the same vein, the examiner considers the specification to be non-enabling with respect to the claimed subject matter since "[t]he new matter added to the claims, as recited above, is not shown in the drawings and gives no guidance to one of ordinary skill in the

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<sup>1</sup> The written description and enablement requirements are separate and distinct. Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

art [how] to make and/or use the invention" (final rejection, page 4).

With regard to the written description requirement, the test is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the appellants had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The content of the drawings may also be considered in determining compliance with the written description requirement. Id.

The limitations in claims 1, 9 and 16 relating the anchor to the left armpit of a right handed golfer or to the right armpit of a left handed golfer find support in the paragraph bridging pages 5 and 6 in the original specification and in original drawing Figures 5a, 5b and 17. The paragraph bridging specification pages 5 and 6 associates the anchor 26 with the armpit of the golfer's forward arm, and Figures 5a, 5b and 17 illustrate a right handed golfer in a right handed stance with the anchor fitting against the left (forward) armpit. It stands to reason and inherently follows that in a putting aid/brace member designed for a left handed golfer, the anchor would fit

against the golfer's right (forward) armpit.<sup>2</sup> As for the recitation in claim 16 requiring the anchor to be "planar," the original drawing figures show the anchor 26 to be "planar" in the sense that it lies essentially in a single plane. Thus, the originally filed disclosure in the instant application would reasonably convey to the artisan that the appellants had possession at that time of the subject matter now set forth in independent claims 1, 9 and 16, and dependent claims 2 through 8, 10 through 15 and 17 through 24.

Insofar as the enablement requirement is concerned, the dispositive issue is whether the appellants' disclosure, considering the level of ordinary skill in the art as of the date of the application, would have enabled a person of such skill to make and use the claimed invention without undue experimentation. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563-64 (CCPA 1982). In calling into question the enablement of the

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<sup>2</sup> Considered as a whole, the appellants' specification indicates that putting aids/brace members designed for right and left handed golfers, respectively, are mirror images of one another. Thus, the limitations at issue in claims 1, 9 and 16 merely define the respective anchor-armpit relationships embodied by right and left handed putting aids/brace members, and do not call for a putting aid/brace member which can be used by both right and left handed golfers.

appellant's disclosure, the examiner has the initial burden of advancing acceptable reasoning inconsistent with enablement. Id.

In the present case, the examiner has failed to meet the initial burden of cogently explaining why the appellants' disclosure of what is relatively simple and straightforward subject matter would not have enabled a person of ordinary skill in the art to make and use without undue experimentation the putting aid/brace member set forth in independent claims 1, 9 and 16, and dependent claims 2 through 8, 10 through 15 and 17 through 24.

In light of the foregoing, we shall not sustain the standing 35 U.S.C. § 112, first paragraph, rejection of claims 1 through 24.

III. The 35 U.S.C. § 112, second paragraph, rejection of claims 1 through 24

The examiner considers independent claims 1, 9 and 16, and dependent claims 2 through 8, 10 through 15 and 17 through 24, to be indefinite in that:

a) "[r]egarding claim 1, the phrase 'substantially planar' renders the claim(s) indefinite because the claim includes elements not actually disclosed (those encompassed by 'substantially'), thereby rendering the scope of the claims unascertainable" (final rejection, page 4);



b) "Claim 9 recites the limitation 'a triangular position of constant triangle' in the preamble. There is insufficient antecedent basis for this limitation in the claim" (final rejection, page 4); and

c) "Claim 16 recites the limitation 'a locked, triangulated position' in the preamble and 'a planar anchor' in the claim. There is insufficient antecedent basis for this limitation in the claim" (final rejection, pages 4 and 5).

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In determining whether this standard is met, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The definition of the anchor in claim 1 as "substantially planar," although not exact, is nonetheless reasonably precise, and thus does not pose an indefiniteness problem. The examiner's concern with the breadth of this limitation in relation to the

breadth of the disclosure is without merit, and in any event is properly analyzed under the first, rather than the second, paragraph of § 112. As for the noted limitations in claims 9 and 16, the examiner has not explained, nor is it apparent, why these limitations have an insufficient antecedent basis.

Accordingly, we shall not sustain the standing 35 U.S.C. § 112, second paragraph, rejection of claims 1 through 24.

IV. The 35 U.S.C. §§ 102(b) of claims 1 through 16, 22 and 23

Tischler discloses a putting training device designed to "help a golfer develop the proper hinging action at the rearward shoulder in order to develop a unique putting technique called the 'push-it' stroke . . . based on the premise that the golfer should control the putting stroke with a pushing action of the rearward arm" (column 5, lines 1 through 6). As described in the reference, the swing radius of the "push-it" stroke is a line segment of constant length joining the center of the putter head and the center of the rearward shoulder (see column 5, lines 20 through 59). This differs from the conventional "pendulum stroke" wherein the golfer maintains a constant triangle between the arms and shoulders and motion is generated by rocking or rotating the shoulders back and forth around the center of the shoulders which thus becomes the pivot point for the motion (see

column 1, lines 31 through 41). Tischler's training device 10 comprises a semi-rigid rod having a post 18 at one end for

insertion into the handle end of a putter and a crutch arm 16 at the other end for placement against the armpit under the rearward shoulder of the golfer, i.e., the right shoulder of a right handed golfer or the left shoulder of a left handed golfer (see column 3, line 41 et seq.).

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

As appears to be conceded by the examiner (see page 7 in the final rejection), the Tischler training device, shaped such that its anchor, crutch arm 16, is positioned for placement against the right armpit of a right handed golfer or the left armpit of a left handed golfer, lacks the configuration necessary to meet the limitations in independent claims 1, 9 and 16 relating the anchor to the left armpit of a right handed golfer or the right armpit of a left handed golfer. This training device 10, constructed to effect a "push-it" stroke, also fails to meet the limitations in

claims 1 and 9 relating to the axis centered between the golfer's shoulders (see Tischler's Figures 3A, 5A and 5B). Hence, the examiner's determination that Tischler is anticipatory with respect to the subject matter recited in claims 1, 9 and 16 is unsound.

Accordingly, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of claims 1, 9 and 16, and dependent claims 2 through 8, 10 through 15, 22 and 23, as being anticipated by Tischler.

V. The alternative 35 U.S.C. § 103(a) rejection of claims 1 through 16, 22 and 23

Acknowledging that Tischler fails to meet the limitations in independent claims 1, 9 and 16 relating the anchor to the left armpit of a right handed golfer or the right armpit of a left handed golfer, the examiner concludes that it would have been obvious to a person of ordinary skill in the art "that the Tischler device can be used under either [the] right or left armpit and by either a right-handed or a left-handed golfer. In the Tischler device, the anchor could be adjusted, based on the golfer's stance and the golfer's choice, under either the right or the left armpit" (final rejection, page 7). In short, Tischler not only lacks factual support for this conclusion, it clearly teaches away therefrom.

Accordingly, we shall not sustain the standing alternative 35 U.S.C. § 103(a) rejection of claims 1, 9 and 16, and dependent claims 2 through 8, 10 through 15, 22 and 23, as being obvious over Tischler.

VI. The 35 U.S.C. § 103(a) rejection of claims 17 through 20

Claims 17 through 20 depend from independent claim 16 and define the brace member recited therein as embodying various angles. For the reasons expressed above, Tischler would not have suggested the subject matter recited in parent claim 16. Moreover, the examiner's position (see pages 7 and 8 in the final rejection) that the angles set forth in claims 17 through 20 are taught by, or would have been obvious over, Tischler is completely lacking in factual support.

Hence, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 17 through 20 as being unpatentable over Tischler.

VI. The 35 U.S.C. § 103(a) rejection of claims 21 and 24

As the telescopic golf club shafts for which Harrison and Middleton are cited (see pages 8 and 9 in the final rejection) fail to cure the foregoing deficiencies of Tischler with respect to parent claim 16, we shall not sustain the standing 35 U.S.C.

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§ 103(a) rejection of dependent claims 21 and 24 as being  
unpatentable over Tischler in view of Harrison and Middleton.

SUMMARY

Since none of the examiner's rejections is sustained, the  
decision of the examiner to reject claims 1 through 24 is  
reversed.

REVERSED

CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
	)	
	)	APPEALS AND
LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	INTERFERENCES
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JOHN P. MCQUADE	)	
Administrative Patent Judge	)	

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